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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ernst Mauch

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EXAMINER

HAYES, BRET C

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,374	Applicant(s) MAUCH ET AL.	
	Examiner Bret C. Hayes	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 26, 27 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) 3-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 20, 22-24, 26, 27, 35 and 37 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. While the examiner appreciates Applicant's diligence in reviewing the restriction practices and procedures, with respect to the response entered 19 APR 06, the examiner submits the following.

2. With respect to the allegation that, "[t]he response filed on June 30, 2005, pointed out the fact that the Office action dated May 18, 2005, did not make any showing as to the required rationales of independence, distinctiveness, or examiner's burden. As such, the May 18, 2005, Office action, did not put the applicant in a position to meaningfully address the election requirement because the action was devoid of rationale regarding the required criteria for restriction. therefore, the Office action did not help to advance the prosecution of the case by clarifying the issues." The restriction requirement read along these lines:

A. ...first module...and a second module; and,

B. ...first module...and a blank module.

The response to which was to amend the claims to eliminate any and all recitations of a blank module and then argue that no showing of rationale had been given. This seems rather unfair. In the examiner's response dated 13 OCT 05, rationale is set forth that a second module implies a certain similarity to a first module that a blank module does not. In any case, the point was rendered moot by the amendment indicated above. The next portion of the restriction requirement indicates that an election of species must be made wherein the device:

1. prevents firing by all persons; and,
2. permits firing by all persons.

Art Unit: 3641

Arguably, the examiner had failed to provide rationale, but hopes to rectify that herewith. It was the examiner's understanding that the two embodiments (prevents all vs. permits all) would require less than normal verbiage to explain. Here it is: The two embodiments depart in scope in completely opposite directions. Because every other embodiment requiring election (of the elected invention at least) depended upon one of these two embodiments, the remainder of the election was equally devoid of tautology to clarify what the examiner had mistakenly understood as being readily apparent. Apologies.

3. It is alleged that claims 1 – 22, 26, 27 & 35 – 37 all overcome the prior art or depend upon an allowable, generic claim. Examiner disagrees. Examiner will treat claims 1, 2, 20, 22 – 24, 26, 27 & 35 – 37 further on the merits. Note: claim 10 has the improper status identifier “(Previously Presented)”, which should be --(Withdrawn)--.

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 20, 22, 26, 27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teetzel (previously cited).

Art Unit: 3641

7. Re – claims 1 & 37, Teetzel discloses the claimed invention including a firearm 70 comprising a housing having a handle, best seen in Fig. 1, for example, a safety 48, for example, a first module 12 removably attachable to the handle, as set forth at col. 3, line 41+, for example, the first module 12 containing an electronic identification device (*EID*), see Fig. 3, for example, the *EID* operatively connected to the safety 48. However, Teetzel does not disclose a second module removably attachable to the handle in place of the first module such that the first and second modules are interchangeable, the second module interacting with the safety when the second module is attached to the handle to affect the ability to fire the firearm. Because there is nothing especially distinguishing in the claims regarding the first and second modules, in that the first module also “interacts with the safety when the first module is attached to the handle to affect the ability to fire the firearm” just as the second, this is considered to be duplication of parts. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a second module (interchangeable with the first...), since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, one would be motivated to have a replacement module in the event of loss, damage, etc. – like having an extra house key somewhere. Re – claim 37 more specifically, the second module would inherently interact with the safety just as the first one does. Further, it is well known in the art that once a mechanical safety is “on”, it prevents firing by all users as claimed. If not inherent, it would be obvious to one of ordinary skill in the art at the time the invention was made to have the safety so prevent all users as claimed.

Art Unit: 3641

8. Re – claim 2, Teetzel discloses further comprising a memory, as set forth at col. 3, lines 54 – 60, col. 4, lines 28 – 37, and col. 4, lines 61 – 65, for example. While examiner concedes that there is no explicit mention of the term “memory”, it would be inherent in the device as the only way for a voice recognition chip to authenticate an operator’s speech pattern as disclosed would be to compare a pattern given with one stored. Stored where? In a memory.

9. Re – claim 20, Teetzel discloses the claimed invention as applied above. The memory need only be capable of performing the intended use, which it is.

10. Re – claim 22, Teetzel discloses the safety operative to prevent firing as claimed. It is noted that in the base claim the safety selectively prevents firing. As most safeties are of this design, it would be a part of any normal firearm in the art. As such, whether the first module was attached or removed would be irrelevant. Further, the safety is capable of preventing firing in the event the first module is removed as claimed – see Abstract, for example.

11. Re – claim 26, Teetzel discloses the claimed invention including a contact sensor 18, which activates the safety 48. However, Teetzel does not disclose the sensor activating the safety when the sensor is released. The sensor of Teetzel is a microphone. However, Teetzel discloses the use of a heat sensor combining to affect the safety, as set forth at col. 1, lines 41 – 51, for example. Clearly, Teetzel contemplated this design as well.

12. Re – claim 27, Teetzel discloses the claimed invention including wherein the firearm has a firearm identification number. It is inherent that all firearms have identification numbers. This is a matter of law. Teetzel discloses the safety operative to prevent firing as claimed and the memory would certainly be capable of storing the identification number as claimed.

Art Unit: 3641

13. Re – claim 35, Teetzel discloses the claimed invention as applied above. Because Teetzel explains that the signal is unique to the weapon, were one to use another ‘interchangeable’ module having an incorrect signal, it would be incapable of releasing the safety as claimed.

Allowable Subject Matter

14. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov. The examiner can

Art Unit: 3641

normally be reached Monday through Thursday from 5:30 am to 4:00 pm, Eastern Standard Time.

The Central FAX Number is **571-273-8300**.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

Bret Hayes

27-Jun-06



MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER